

Remarks

The present amendment is made in response to the Office Action dated February 27 2007, and identified as Paper No. 20070218. Claims 13-20 are pending in the present application.

In the Action, the Examiner rejected claims 13 and 15-18 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0065682 to Goldenberg (*Goldenberg*), claim 14 under 35 U.S.C. 103(a) as being unpatentable over *Goldenberg* in view of U.S. Patent Application Publication No. 2001/0032099 to Joao (*Joao*), and claims 19-21 under 35 U.S.C. 103(a) as being unpatentable over *Goldenberg* in view of U.S. Patent No. 6,505,166 to Stephanou (*Stephanou*).

I. Finality of Second Office Action was Improper under MPEP § 706.07(a)

As explained in the prior Reply, Applicant rewrote the claims in an attempt to more clearly recite method of the present invention, *but did not introduce any new matter into the claims*. Applicant also entered arguments as to why the claimed invention was not disclosed in the cited references. The Examiner apparently agreed with Applicant's arguments, but found the arguments to be moot in view of new grounds of rejection using new art. As Applicant's amendment did not change the scope of the claims, they could not have necessitated the new ground of rejection. As a result, the pending office action should not have been made final under MPEP § 706.07(a) and Applicant is entitled to a refund of the fees associated with the present Request for Continuing Examination. Applicant hereby grants authority to refund the fees to Deposit Account No, 50-1546.

II. Rejections under 35 U.S.C. § 102(e) in view of *Goldenberg*

According to the Examiner, *Goldenberg* discloses all of the elements of the claimed invention. This is not correct. *Goldenberg* fails to disclose several of the claimed steps of present invention.

Goldenberg discloses a system for enabling *patients* to remotely connect with physicians to obtain updated information about diagnoses and condition. The claimed invention, however, is a system and method that allows "*clients*" to locate and facilitate referrals to specialists.

"Clients" is specifically defined on page 7, line 4 and on page 14, lines 13-16 of the specification of the present invention to be *health care payors*, such as insurance companies and self-insured employers. The term "client" as used in the present application is thus quite distinct from the term patient, which is used in its conventional manner to refer to the individuals that actually receive medical treatment from physicians rather than the insurance companies that pay for the services. The term "client" thus does not encompass "patient," or vice-versa.

Following is an element-by-element explanation of how the invention recited in the claims of the present application is significantly different than the system discloses in *Goldenberg*.

First, the claimed invention recites "providing secure access to the network to a client through a computer terminal." As defined in the specification, a "client" is a payor or employer. *Goldenberg* discloses an online system that is accessed by a patient, not a payor or employer. These terms have completely different meanings. A patient is not a client, and a client is not a patient. An applicant is free to be his or her own lexicographer, *see* MPEP § 2111.01, and Applicant has specifically defined what is meant by the term "client" in the present invention, and the meaning of that term is clearly distinct from the meaning of the term "patient." The

Examiner is not free to depart from those meanings. Accordingly, the Examiner cannot construe "client" to mean "patient" when it is abundantly clear that the terms have diametrically opposed meanings. A patient obviously receives medical services, while the client is responsible for payment of those services through an employment or insurance obligation.

Second, the claimed invention recites "allowing said client to request a referral for a specific medical need." *Goldenberg* discloses an online system that allows a patient to request a referral, not a payor or employer.

Third, the claimed invention recites "displaying said information [the referral database information] for said client" and "allowing said client to select said at least one physician allowing said client to request a referral for a specific medical need." *Goldenberg* displays and allows a patient to request the referral, not a payor or employer.

Fourth, the claimed invention recites "requesting a response from said client to at least one inquiry established by said at least one physician," thereby allowing the physician to request patient information from the payor or employer. *Goldenberg* only provides for the physician to ask questions to the patient, not for the physician to ask questions to the payor or employer. This is clearly a very different step as different parties are involved.

Fifth, the claimed invention recites "securely transmitting patient information from a client database to said at least one physician after receiving a response to said inquiry." *Goldenberg* does not provide for the transmittal of information from a client database to a physician in response to an inquiry. In the portion of the specification identified by the Examiner as disclosing this element, *Goldenberg* generally discloses a database but does not disclose transmitting information from a client database to a physician in response to an inquiry.

Thus, Goldenberg fails to disclose both limitations, namely transmitting information from a client database *and* transmitting that information in response to a physician inquiry

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Sixth, the claimed invention recites "tracking said request [the request for the referral] to ensure that the medical services are provided." *Goldenberg* only provides for selecting another physician if the first selected physician cannot provide the services. Selecting another physician is not "ensuring the services are actually provided" as there is no way to know whether the second physician actually performs the services. *Goldenberg* simply lets a patient *select* another available physician, and does not *ensure* or verify that the services are in fact performed. These are two very different things. This missing element highlights the vast differences between the system of the claimed invention, which is directed toward "clients," verses one that is directed toward patients, as in *Goldenberg*. A patient doesn't need to verify if the medical services are in fact provided because the patient gets the services directly from the physician and thus knows whether the services are performed. A client, however, is a third party to the medical treatment and thus needs verification whether the services are actually provided by the physician to the patient. *Goldenberg* does not disclose the claimed step of verifying that services were in fact provided.

Notably, the fact that these elements are lacking is evidence from the Examiner's analysis of the claim elements, where the Examiner properly recites the term "clients" from the claimed invention, but only points to steps involving "patients" in *Goldenberg*. *Goldenberg* thus fails to disclose *at least six of the express claim elements* of the present invention. As these elements are completely lacking from any of the cited references, the Examiner had failed to state a *prima facie* case of anticipation or obviousness and the rejections must be withdrawn.

Response to Office Action dated February 27, 2007
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RCE and Submission dated May 29, 2007

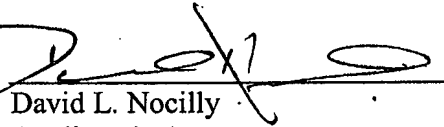
In view of the foregoing, the Examiner's reconsideration and allowance of the claims of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, please contact the undersigned at (315) 218-8530.

Respectfully submitted,

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